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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,260	10/16/2006	John Colgrave	GB920030007US1	5696
75949	7590	09/08/2011		
IBM CORPORATION C/O: VanCott Bagley, Cornwall & McCarthy 36 South State Street Suite 1900 Salt Lake City, UT 84111			EXAMINER COPPOLA, JACOB C	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 09/08/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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IBM CORPORATION
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In re application of
John Colgrave
Application No. 10/561,260
Filed: December 16, 2005
For: USER ACCESS TO A REGISTRY OF
BUSINESS ENTITY DEFINITIONS

**DECISION ON PETITION
UNDER 37 CFR § 1.181**

This is a decision on the petition filed under 37 CFR §1.181 on May 12, 2011 to request entry of the declarations filed on October 5, 2010.

The petition is **DISMISSED**.

A review of the file record reveals that responding to the non-final Office action dated February 19, 2010, applicant filed an amendment on May 18, 2010 arguing the indefiniteness rejection under 35 USC 112, second paragraph on the terms "business entity definition," "business service entity information element," "binding template information element," "technical model information element," and "business entity information element." A final Office action was mailed on August 4, 2010 in which the examiner repeated the indefiniteness rejection under 35 USC 112, second paragraph on said terms. In response to the final Office action, applicant filed a declaration on October 5, 2010 which includes four exhibits to provide evidentiary support for applicant's position that the disputed terms are well known in the art. Subsequently, applicant filed a notice of appeal on October 6, 2010 and an appeal brief on December 2, 2010. In an advisory action mailed on April 27, 2011, the examiner indicated that the declarations and exhibits have not been entered on the grounds that applicant failed to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented.

Applicant argues in the petition that the examiner has erred in refusing to enter the declaration/exhibits pursuant to 37 CFR 41.33 (d)(1) on the grounds that applicant has not provided good and sufficient reasons why the declaration is necessary and was not earlier presented, and in using the "advisory action before the filing of an appeal brief" form. Applicant also argues that entry of the declaration/exhibits is necessary for the pending appeal as the exhibits provide evidence that the rejection under 35 USC 112,

second paragraph is without basis, and the appeal brief has already referenced the declaration/exhibits extensively.

MPEP § 714.12 states that:

An affidavit or other evidence filed after a final rejection, but before or on the same date of filing an appeal, may be entered upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e).

Rule 37 CFR § 1.116 (e) with regard to “Amendments and affidavits or other evidence after final action and prior to appeal” states that:

An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

MPEP § 714.13 (III) states that:

Advisory Action Before the Filing of an Appeal Brief form PTOL-303 should be used to acknowledge receipt of a reply from applicant after final rejection where such reply is prior to filing of an appeal brief and does not place the application in condition for allowance. This form has been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the application in condition for allowance or which could not be made allowable by a telephone call to clear up minor matters.

In response to applicant’s argument that the examiner erred in refusing to enter the declaration/exhibits pursuant to 37 CFR 41.33 (d)(1), and in using the wrong advisory form, applicant is incorrect in asserting that the examiner has used the wrong advisory form. Since applicant filed a response to the final rejection before the filing of an appeal brief, it is appropriate to use the “*Advisory Action Before the Filing of an Appeal Brief*” form (PTOL-303) as dictated by MPEP § 714.13, section III cited above. On the other hand, applicant is correct in that rule 37 CFR 41.33 (d)(1) does not apply since the declaration/exhibits were filed on October 5, 2010 which was before the date of filing an appeal brief – the appeal brief was filed on December 2, 2010. The examiner made a mistake in checking box 9 on the advisory action. Since rule 37 CFR § 1.116(e) applies to a situation where the affidavit is filed after a final action but before or on the date of filing a notice of appeal, it is clear the box 8 should have been checked on the advisory action. However, the examiner’s mistake in checking the wrong box on the advisory action does not excuse applicant from complying with the requirement of “a showing of good and good and sufficient reasons why the declaration/exhibits is necessary and was not earlier presented” as dictated by MPEP § 1.116 (e). Therefore, applicant’s arguments are not persuasive. A review of the declaration/exhibits revealed that applicant provides no explanation why the declaration/exhibits is necessary and was not earlier presented.

In response to applicant’s argument that the examiner has erred in refusing to enter the declaration/exhibits on the grounds that applicant has not provided good and sufficient reasons why the

declaration is necessary and was not earlier presented, it is noted that since the rejection under 35 USC 112, second paragraph was first made in the non-final Office action dated February 19, 2010, applicant could have provided the declaration/exhibits in his response to the non-final Office action and before the final Office action was issued. Applicant pointed out in the petition that in the amendment filed on May 18, 2010 applicant cited an online version of the UDDI Specification which clearly sets forth the meaning of the disputed terms. However, as correctly pointing out by the examiner in the final Office action of August 4, 2010 since the publication date of the cited online document is not known, the examiner cannot determine if the document is valid for establishing that the disputed terms is old and well known. Therefore, the examiner was correct in his determination that the cited online document was not sufficient to overcome the rejection under 35 USC 112, second paragraph. It is also worth pointing out that because the content of an online link/posting may be modified/updated over time, one should not rely on an online link to be valid evidence. Applicant also argues that the examiner specifically requested in the final Office action that applicant provide in the next response verifiable evidence on the record that the disputed terms are well known in the art. It is noted that the declaration/exhibits were submitted after the examiner repeated the rejection under 35 USC 112, second paragraph in the final Office action. As applicant chose to submit the declaration/exhibits as new evidence after the final rejection, he has to comply with the requirement set forth in MPEP § 1.116 (e) to have the declaration/exhibits entered into the record. Therefore, applicant's arguments are not persuasive.

To include evidence in the appeal proceedings, applicant must comply with the requirements of rule 37 C.F.R. § 41.37 (c)(1)(ix):

Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

It is clear from the advisory action dated April 27, 2011 that the declaration/exhibits have not been entered by the examiner. As such, these new evidence do not satisfy the requirements of 37 C.F.R. § 41.37 (c)(1)(ix) for consideration on appeal. In response to applicant's arguments that that entry of the declaration/exhibits is necessary for the pending appeal as the exhibits provide evidence that the rejection under 35 USC 112, second paragraph is without basis, and the appeal brief has already referenced the declaration/exhibits extensively, it is noted that new evidence cannot be introduced into the appeal proceeding without the examiner's approval for entry into the record as stated in 37 C.F.R. § 41.37 (c)(1)(ix). It is improper for applicant to introduce new evidence in the appeal brief when the new evidence did not meet the requirement set forth in MPEP § 1.116 (e) cited above, and the examiner has not had a chance to properly consider the evidence or approved its entry.

For the foregoing reasons, applicant's request to enter the declaration/exhibits into the record is dismissed as applicant failed to comply with the requirements set forth in MPEP § 1.116 (e) and 37 C.F.R. § 41.37 (c)(1)(ix).

Any questions regarding this letter should be directed to Quality Assurance Specialist Lanna Mai at (571) 272-6867.



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lm: 8/22/11

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